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EXAMINER

EGAN, BRIAN P

ART UNIT

PAPER NUMBER

1772

DATE MAILED: 07/02/2003


Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/037,632

Applicant(s)

WILLIAMS, DOUGLAS C. 

Examiner

Brian P. Egan

Art Unit

1772

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 1-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Claims 9-23 in Paper No. 3 is acknowledged.

### ***Claim Interpretation***

2. The limitation "wherein the article of manufacture is assembled prior to assembly to roof rafters" in independent claims 9, 14, and 19 (as well as the subsequent dependent claims) is given little to no patentable weight. The aforementioned limitation is directed at the method of forming the end product. The method of forming the article and/or the order in which the product layers are assembled is not germane to the issue of patentability of the article itself.

### ***Specification***

3. The abstract of the disclosure is objected to. The abstract must be limited to one paragraph and 150 words or less. Correction is required. See MPEP § 608.01(b).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as his invention. It is unclear how the vapor, water, and ice resistant layer is arranged and whether the adhesive layer is part of the vapor, water, and ice resistant layer. Is the adhesive layer the vapor, water,

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and ice resistant layer? Is the adhesive layer interposed between the vapor, water, and ice resistant layer and the plastic film? Is the adhesive layer intended to be vapor, water, and ice resistant as well? Proper clarification and/or correction are required.

6. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, for failing to provide proper antecedent basis for "the vapor, water, and ice resistant layer." Proper clarification and/or correction are required.

*Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9-12, 14-17, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (#5,096,759) in view of Harkness (#4,775,567).

Simpson et al. teach an article of manufacture for reducing water damage on a roof comprising a sheathing panel for assembling on the roof rafters having a first face and a second face (see Fig. 10), a high density polyethylene film layer (Col. 1, lines 50-56), an adhesive layer (Fig. 1, #24), and a plastic film covering the adhesive layer (Fig. 1, #26). The article comprises means for removing the plastic film to expose the adhesive backing and means for assembling the article to the sheathing panel (see Fig. 2; Col. 5, lines 55-62). The article comprises marking means for positioning a corner of the article at a corner of the sheathing panel and aligning their longitudinal edges (Col. 4, lines 8-17). Although Simpson et al. do not explicitly teach that the

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article either completely covers or covers approximately three-fourths of the first face of the sheathing panel, Simpson et al. teach that the roofing is manufactured to be wound into a spiral roll and cut to appropriate sizes. Therefore, depending on the desired end product, it would have been obvious to change the size of the roofing material such that it either completely covers or covers three-fourths of the first face of the sheathing panel (Col. 2, lines 4-9). Furthermore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified the size of the article such that it either completely covers or covers three-fourths of the sheathing panel since such a modification would have involved a mere change in the size of a component – a change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

Simpson et al. further teach that the roofing material is arranged in such a way so as to prevent leaks (Col. 5, lines 43-47) but fail to explicitly state that the high density polyethylene film layer is water, vapor, and ice resistant.

Harkness, however, teaches a waterproofing laminate for use in roofs wherein the waterproofing laminate material is selected from multiple different polyethylene materials (Col. 3, lines 1-6). The waterproofing laminate is used for the purpose of resisting undesired penetration of water ("water" implicitly includes ice) and water vapor (Col. 2, lines 14-17). It would have been obvious through routine experimentation to one of ordinary skill in the art to select a polyethylene based material based on its waterproofing properties for the purpose of providing a roofing laminate that resists undesired penetration of water and water vapor as taught by Harkness.

Therefore, it would have been obvious to one of ordinary skill in the art at the time Applicant's invention was made to have modified Simpson et al. to replace the high density polyethylene laminate with a polyethylene waterproofing laminate as taught by Harness in order to provide a roofing laminate that resists undesired penetration of water and water vapor.

9. Claims 13, 18, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simpson et al. (#5,096,759) in view of Harkness (#4,775,567), and further in view of Sancaktar (#4,965,119).

Simpson et al. and Harkness teach a roofing material as detailed above. The aforementioned prior art fails to teach a seam tape attached to the assembly for sealing an area between a second abutting assembly.

Sancaktar, however, teaches a seam tape for roofing materials for attaching adjacent roofing members in a lap joint arrangement (Col. 1, lines 45-49; Fig. 4). Sancaktar teaches the use of seam tape to attach abutting strips of material for the purpose of providing optimum protection against moisture and/or other environmental conditions (Col. 1, lines 40-49). It would have been obvious through routine experimentation to providing abutting roofing laminates with a seam tape therein providing the abutting roofing laminates with a lap joint for the purpose of providing optimum protection against moisture and/or other environmental conditions as taught by Sancaktar.

Therefore, it would have been obvious to one of ordinary skill in the art to have modified the aforementioned prior art by providing a seam tape as taught by Sancaktar in order to provide optimum protection against moisture and/or other environmental conditions.

*Conclusion*

10. Although not relied upon in the above 35 U.S.C. 103(a) rejections, the Examiner would like to bring to the Applicant's attention several other prior art references that are pertinent to the field of the Applicant's claimed invention. These include GB #1,598,071, U.S. # 2003/0054127, U.S. #6,235,365, U.S. #5,843,552, U.S. #4,601,935, and the WeatherWatch Leak Barrier provided by GAF Materials Corporation (see [http://www.gaf.com/content/GAF/RES1/ROOF/RS\\_WeatherWatch.html](http://www.gaf.com/content/GAF/RES1/ROOF/RS_WeatherWatch.html)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian P. Egan whose telephone number is 703-305-3144. The examiner can normally be reached on M-F, 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on 703-308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
BPE

June 23, 2003

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER

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6/25/03